

REMARKS

Claims 2, 3, 7, 9, and 15 to 17 are canceled without prejudice, and claims 1, 4, 5, 6, 8, and 10 to 14 are currently pending in the present application.

It is respectfully submitted that all of the presently pending claims are allowable, and reconsideration of the present application is respectfully requested.

Applicants thank the Examiner for indicating that claims 15, 16 and 17 contain allowable subject matter. While the objections may not be agreed with, to facilitate matters, claim 1 is rewritten to include the features of claim 16, claim 10 is rewritten to include the features of claim 17, and claim 13 is rewritten to include the features of claim 15. Accordingly, claims 1, 4, 5, 6, 8, and 10 to 14 are allowable. Claims 2, 3, 7, 9, and 15 to 17 are canceled without prejudice. It is therefore respectfully requested that the objections be withdrawn.

Claims 1 to 8, 10, 11, 13, and 14 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,680,620 ("Ross").

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the prior Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a "basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied art." (*See* M.P.E.P. § 2112; emphasis in original; and *see Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

While the rejections may not be agreed with, to facilitate matters, claim 1 is rewritten to include the features of claim 16, claim 10 is rewritten to include the features of claim 17, and claim 13 is rewritten to include the features of claim 15. Claims 2, 3, 7, 9, and 15 to 17 are canceled without prejudice. Accordingly, claims 1, 4, 5, 6, 8, and 10 to 14 are allowable. It is therefore respectfully requested that the anticipation rejections be withdrawn.

Claims 9 and 12 were rejected under 35 U.S.C. § 103(a) as unpatentable over Ross in view of U.S. Patent No. 6,535,811 (“Rowland et al.”).

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there may be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination may be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

As clearly indicated by the Supreme Court, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

While the rejections may not be agreed with, to facilitate matters, claim 1 is rewritten to include the features of claim 16, claim 10 is rewritten to include the features of claim 17, and claim 13 is rewritten to include the features of claim 15. Claims 2, 3, 7, 9, and 15 to 17

are canceled without prejudice. Accordingly, claims 1, 4, 5, 6, 8, and 10 to 14 are allowable. It is therefore respectfully requested that the obviousness rejections be withdrawn.

It is therefore respectfully submitted that claims 1, 4, 5, 6, 8, and 10 to 14 are allowable.

CONCLUSION

It is therefore respectfully submitted that all of the presently pending claims are allowable. It is therefore respectfully requested that the rejections and objections be withdrawn, since all issues raised have been addressed and obviated. An early and favorable action on the merits is respectfully requested.

Respectfully submitted,

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